

### REMARKS

The Examiner objected to Claims 3 and 9 under 37 CFR 1.175(c). The above amendments cancel these claims, and hence, render the issue moot.

The Examiner objected to Claim 7 because the syntax of that claimed required clarification. The above amendments cancel Claim 7 and provide the required clarification in those claims that previously depended from Claim 7 and are now written in independent form.

The Examiner rejected claims 1, 3, 5, 6, 7, 9, 11 and 12 under 35 U.S.C. 102(e) as being anticipated by Hess, *et al* (hereafter "Hess"). Applicant submits that the above amendments render this rejection moot, since the claims in question have either been canceled or amended to include features that the Examiner admits are not taught in Hess.

The Examiner rejected Claims 4 and 10 under 35 U.S.C. 103(a) as being unpatentable over Hess in view of Tullis US 6,118,132. Applicant traverses this rejection. Where the claimed subject matter has been rejected as obvious in view of a combination of prior art references, a proper analysis under section 103 requires, *inter alia*, consideration of two factors: (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process; and (2) whether the prior art would also have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success... Both the suggestion and the reasonable expectation of success must be founded in the prior art, not in the applicant's disclosure. *In re Vaeck*, 20 USPQ2d 1438, 1442(CAFC 1991).

In making this rejection, the Examiner admits that Hess does not teach that the imaging device comprises an image sensor for generating a one-dimensional image of the print medium in a direction parallel to the predetermined direction. The Examiner looks to Tullis as providing the missing teaching. The Examiner states that the motivation for combining the teachings is the reduction of the computational complexity.

Applicant submits that the use of a one-dimensional image sensor in the apparatus of Hess leads to an inoperative device, and hence, there is no reasonable expectation of success.

The floor printer taught in Hess must move over a two-dimensional surface and correct for deviations from the desired direction of motion; hence, successive images must be capable of determining the two-dimensional displacement that occurred between the images. A one-dimensional image sensor cannot provide that information. Hence, the Examiner has failed to make a *prima facie* case for obviousness with reference to Claims 4 and 10.

The Examiner rejected Claims 2 and 8 under 35 U.S.C. 103(a) as being unpatentable over Hess in view of Hoshino, *et al* (hereafter "Hoshino") US 6,709,085. Applicant traverses this rejection.

The Examiner admits that that Hess does not teach the input signal to the actuator is varied in response to the determined displacement so as to reduce fluctuations in speed. The Examiner looks to Hoshino as providing the missing teachings. According to the Examiner, Hoshino discloses a self motorized inkjet printer similar to the type described by Hess in which images of the print surface are detected and an input signal to an actuator (9) moves a print head assembly to compensate for the displacement of the print head being outside a predetermined range so as to reduce fluctuations in the speed. The Examiner points to the passages at col. 9, lines 41-60 and col. 11, lines 18-30 as supporting this assertion.

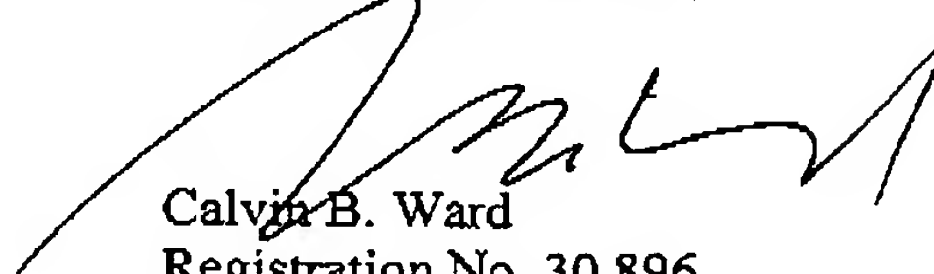
Applicant must disagree with the Examiner's reading of Hoshino. With reference to the passage at column 9, the system taught in Hoshino tracks an invisible straight line. The cited passage refers to the correction of the direction of travel when the controller in the device determines that the device has strayed from the straight line by more than the allowed tolerance. In such a case, the appropriate motor is activated to return the print head to the correct direction of travel. Hence, this passage does teach that the correction reduces fluctuations in the speed of the print head.

With reference to the passage at column 11, Hoshino teaches compensating for variations in the speed of the wheels of the apparatus to force the apparatus to move in the correct direction. The cited passage does not teach changing the speed of the motors to reduce fluctuations in the speed of the device across the print medium as required by the claims in question. Hence, the combination of the two references does not teach all of the

limitations of the claims. Accordingly, Applicant submits that the Examiner has not made a *prima facie* case for obviousness with reference to Claims 2 and 8.

I hereby certify that this paper is being sent by FAX to 703-872-9306.

Respectfully Submitted,



Calvin B. Ward  
Registration No. 30,896  
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Agilent Technologies, Inc.  
Legal Department, M/S DL429  
Intellectual Property Administration  
P.O. Box 7599  
Loveland, CO 80537-0599  
Telephone (925) 855-0413  
Telefax (925) 855-9214